

**REMARKS**

The above referenced application has been reviewed in light of the Final Office Action mailed December 6, 2006. By the present amendment, Applicants have amended Claims 1, 14, 27 and 30. Applicants respectfully submit that the claims presently pending in the application, namely Claims 1-6, 14, 21 and 27-31, do not introduce new subject matter, are fully supported by the application and are patentable over the prior art of record. Claims 7-13, 15-20, 22-26, and 32 have been previously withdrawn in response to a Restriction/Election of Species Requirement dated June 2, 2006. Prompt and favorable reconsideration of the claims as presented and/or as amended herein is earnestly solicited.

The Examiners suggestions and recommendations are acknowledged and gratefully appreciated.

**Rejection(s) under 35 U.S.C. § 102(b)**

Claim 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,254,117 to Rigby ("Rigby"). Applicants respectfully submit that independent Claim 1, as amended and/or presented herein, is allowable over Rigby because Rigby fails to fully anticipate independent Claim 1.

Independent Claim 1 presently recites an electrosurgical pencil including, *inter alia*, a housing containing a fluid supply source; and an aspirating/irrigating system

integrally formed with the housing, wherein the aspirating/irrigating system is configured and adapted to manually perform at least one of delivering a quantity of fluid from the fluid supply source to a target surgical site and withdrawing a quantity of fluid from the target surgical site into the fluid supply source.

As seen throughout the figures of the present application, electrosurgical pencil 100 includes a housing 102 containing a fluid supply source therein. According to the present disclosure, when handle 142 is urged from its fully expanded condition to its non-fully expanded condition (e.g., to at least partially evacuate chamber 144), a fluid "F", contained within chamber 144 of handle 142, is urged and/or squeezed through fluid passage 146 and out through aperture(s) 148. (see paragraph [0059]). Similarly, when handle 142 is allowed to return to its fully expanded condition, from its non-fully expanded condition, (e.g., as by allowing resilient handle 142 to overcome the squeezing and/or compressing forces and to return to its fully expanded condition), as described above, a suction is created at apertures 148, through fluid passage 146, to withdraw fluid "F" into chamber 144. (see paragraph [0059]).

In contrast thereto, Rigby discloses an apparatus 10 including a pistol grip 42 and suction and irrigation hoses 12, 16. Suction hose 12 connects to a source of negative pressure (not shown in Rigby), while irrigation hose 16 connects to a source of positive fluid pressure (also not shown in Rigby). As seen in Rigby, hoses 12 and 16 extend away from pistol grip 42. Accordingly, Applicants respectfully submit that hoses

12 and 16 must necessarily connect to sources of fluid which are located remotely of apparatus 10.

Therefore, for the reason stated above, Rigby fails to show, teach and/or suggest an electrosurgical pencil including, inter alia, a housing containing a fluid supply source; and an aspirating/irrigating system integrally formed with the housing, wherein the aspirating/irrigating system is configured and adapted to manually perform at least one of delivering a quantity of fluid from the fluid supply source to a target surgical site and withdrawing a quantity of fluid from the target surgical site into the fluid supply source, as called for in amended Claim 1. Accordingly, Applicants submit that in view of the amendments to Claim 1, and in view of the arguments presented above, Claim 1 is neither anticipated nor rendered obvious by Rigby.

Since Claims 2-4 depend from Claim 1, for at least the reasons stated above, Claims 2-4 are also neither anticipated nor rendered obvious by Rigby.

**Rejection(s) under 35 U.S.C. § 102(b) and § 103(a)**

Claims 1-6, 21, 27-28 and 30-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application No. 2002/0151886 to Wood ("Wood"). Applicants respectfully submit that each of independent Claims 1, 21, 27 and 30, as amended

and/or presented herein, is allowable over Wood because Wood fails to anticipate and/or render obvious any of independent Claims 1, 21, 27 and 30.

Independent Claim 1 presently recites an electrosurgical pencil including, *inter alia*, a housing containing a fluid supply source; and an aspirating/irrigating system integrally formed with the housing, wherein the aspirating/irrigating system is configured and adapted to manually perform at least one of delivering a quantity of fluid from the fluid supply source to a target surgical site and withdrawing a quantity of fluid from the target surgical site into the fluid supply source.

Independent Claim 21 presently recites an electrosurgical pencil including, *inter alia*, a self-contained, manual aspirating/irrigating system including a body portion defining at least one chamber therein for containing a supply of fluid.

Independent Claim 27 presently recites a method of aspirating/irrigating a target surgical site during an electrosurgical procedure, including the steps of, *inter alia*, providing an electrosurgical pencil having a housing containing a fluid supply source therein, and an aspirating/irrigating system operatively connected to the housing, wherein the aspirating/irrigating system includes a resilient handle which is configured and adapted to deliver a quantity of fluid from the fluid supply source contained in the handle to a target surgical site when the handle is compressed and withdraw a quantity of fluid into the fluid supply source from the target surgical site when the handle is allowed to expand; and at least one of compressing the handle to deliver the quantity of fluid contained in the fluid supply source of the handle to the target surgical site and

allowing the handle to expand to withdraw a quantity of fluid from the target surgical site into the fluid supply source of the handle.

Independent Claim 30 presently recites an electrosurgical pencil including, *inter alia*, a housing containing a fluid supply source therein; and an aspirating/irrigating system supported on the housing and including a resilient handle which defines at least one chamber therein for containing a supply of fluid, wherein said resilient handle is configured such that compression of said handle causes the delivery of a quantity of fluid from the fluid supply source to a target surgical site and expansion of said handle to an uncompressed condition causes the withdrawal of a quantity of fluid from a target surgical site to the fluid supply source.

Conversely, Wood discloses an endoluminal radiofrequency cauterization system that includes, *inter alia*, a catheter 20, an electrode 28 supported within catheter 20, and a syringe 25, separate from the catheter 20, for the injection of liquid into the catheter via a tube (as seen in FIG. 1). Particularly, Wood discloses a catheter having “an injection port 23 that communicates with the hollow interior of catheter 20, and *may receive a syringe 25 or the like for injection of liquid into the catheter.*” (page 4, paragraph 42, *emphasis added*).

Accordingly, Wood fails to show, teach and/or suggest a housing containing a fluid supply source, as substantially called for in each of Claims 1, 21, 27 and 30.

Accordingly, Applicants submit that in view of the amendments made to Claims 1, 21, 27 and 30, and in view of the arguments presented above, that each of Claims 1, 21, 27 and 30 are neither anticipated nor rendered obvious by Wood.

Since Claims 2-6 and 14 depend from Claim 1, for at least the reasons stated above, Claims 2-6 and 14 are also neither anticipated nor rendered obvious by Wood.

Since Claim 28 depends from Claim 27, for at least the reasons stated above, Claim 28 is also neither anticipated nor rendered obvious by Wood.

Since Claim 31 depends from Claim 30, for at least the reasons stated above, Claim 31 is also neither anticipated nor rendered obvious by Wood.

#### Rejection(s) under 35 U.S.C. § 103(a)

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wood in view of U.S. Pat. No.6,352,544 to Spitz ("Spitz"). As noted above, Wood does not disclose or suggest all of the features of Claim 1, the base claim from which Claim 14 depends. The Examiner relies on Spitz for the proposition of the use of a rubber bulb or a syringe as an obvious interchange means for injecting fluid into a catheter lumen. However, Applicants submit that Spitz does not overcome the deficiencies of Wood, i.e., it does not provide any further disclosure or suggestion that, in combination with Wood, would render obvious the electrosurgical pencil of Claim 1. Since, Wood either taken alone or in combination with Spitz, fails to suggest the elements of Claim 1,

and since Claim 14 depends from Claim 1, for at least the reasons presented above, it is respectfully submitted that the rejection of Claim 14 should be withdrawn and that Claim 14 is in condition for allowance.

Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wood in view of U.S. Pat. No. 5,190,541 to Abele ("Abele"). As noted above, Wood does not disclose or suggest all of the steps of Claim 27, the base claim from which Claim 29 depends. The Examiner relies on Abele for the proposition of having an electrosurgical device with a separate suction syringe, in addition to a fluid delivery syringe, for cleaning and removing blood from the surgical area. However, Applicants submit that Abele does not overcome the deficiencies of Wood, i.e., it does not provide any further disclosure or suggestion that, in combination with Wood, would render obvious the electrosurgical pencil of Claim 27. Since, Wood either taken alone or in combination with Abele, fails to suggest the elements of Claim 27, and since Claim 29 depends from Claim 27, for at least the reasons presented above, it is respectfully submitted that the rejection of Claim 29 should be withdrawn and that Claim 29 is in condition for allowance.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that Claims 1-6, 14, 21 and 27-31 are in proper format and are patentably distinct from the prior art of record and are in condition for allowance.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicants' undersigned representative at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted.

  
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